UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,613	07/03/2001	Paul Andrew Moskowitz	YOR920010169US1	1940

7590 10/04/2004

Duke W. Yee
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380

EXAMINER	
REFAI, RAMSEY	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/898,613	MOSKOWITZ ET AL.	
	Examiner	Art Unit	
	Ramsey M Refai	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-99* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-99* is/are rejected.

7)☒ Claim(s) *17,50 and 82* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-99 are presented for examination.

Claim Objections

2. Claims 17, 50, and 82 are objected to because of the following informalities:

- In claim 17: "the method of claim 15" is supposed to be "the method of claim 16", and will be considered such as.
- In claim 50: "the method of claim 48" is supposed to be "the method of claim 49", and will be considered such as.
- In claim 82: "the method of claim 80" is supposed to be "the method of claim 81", and will be considered such as.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12, 14-15, 20, 24-25, 31-32, 35, 37 – 45, 47-48, 53, 57-58, 64-65, 69-77, 79-80, 85, 89-90, and 96-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Appelman (U.S. Patent No. 6,750,881).

5. As per claim 1, Appelman teaches a method in a data processing system within a peer-to-peer network managing processing of requests, the method comprising:

receiving a request from a requestor; comparing preferences within the request to a policy to form a comparison, wherein the policy controls responses by the data processing system to the requests; and selectively responding to the request based on comparison **(column 6, lines 52 – 67 and Figure 11)**.

6. As per claim 2, Appelman teaches a data processing system is a node in the peer-to-peer network **(column 3, lines 20-33 and Figure 1)**.

7. As per claim 3, Appelman teaches a data processing system is a central processing system in the peer-to-peer network **(column 3, lines 10 – 33)**.

8. As per claim 4, Appelman teaches preferences provide parameters for which a response is desired **(column 3, lines 48 – 63 and Figure 2b)**.

9. As per claim 5, Appelman teaches preferences provide parameters for which a response is not desired **(column 3, lines 48 – 63 and Figure 2b)**.

10. As per claim 6, Appelman teaches a requestor is an employee seeking to contact an employer **(Figure 2a and column 3, lines 34 - 47; figure shows a group named "work list", which can include employees and employers communicating using this service)**.

11. As per claim 7, Appelman teaches that a data processing system responds to the request if the preference information for the data processing system indicates that the data processing system is associated with an employer **(Figure 2a and column 3, lines 34 - 47)**.

12. As per claim 8, Appelman teaches the preferences identify a group associated with the requester and wherein the policy allows only interaction with members of a same group **(column 3, lines 34-47, column 4, lines 30 –37 and 45-54 and Figure 2a)**.

13. As per claim 9, Appelman teaches the preferences identify a group associated with the requester and wherein the policy allows only interaction with members of a different group **(column 3, lines 34 –63 and column 5, lines 23-40; each user can have multiple buddy lists by group names, but members of that group can block the user from interaction forcing the user to interact with other user in a different group**.

14. As per claim 10 Appelman teaches the preferences identify a group associated with the requester and wherein the policy allows only interaction with members of selected groups of members **(column 6, lines 18 – 43)**.

15. As per claim 11, Appelman teaches the requestor is a member of a group **(column 3, lines 34 – 47)**.

16. As per claim 12, Appelman teaches wherein groups are based upon at least one of social interaction preferences, dating preferences, music preferences, media preferences, skills of a member, interest, geographic location, membership in an organization, consumption preferences, purchasing history, and expertise **(column 3, lines 34 – 45, column 4, lines 54-63, column 6, lines 17-52 and Figure 10)**.

17. As per claim 14, Appelman teaches generating an outgoing request, wherein the outgoing request includes a request for one of a chat session, instant messaging, or e-mail message **(column 4, lines 37-45)**.

18. As per claim 15, Appelman teaches the request is for interaction with one of a dating service, an information sharing service, a group buying service, instant messaging, electronic mail, distributing software, distributing software upgrades, distributing software fixes, an employment service, a music sharing service, a book sharing service, an image sharing service, and a travel service **(column 6, lines 1-52)**.

19. As per claim 20, Appelman teaches authenticating an identity of the requestor **(column 6, lines 52-67 and Figure 11)**.

20. As per claim 24, Appelman teaches that an existing member of the group can authorize a new member to the group **(column 5, lines 10-40)**.

21. As per claim 25, Appelman teaches that the member of the group can initiate a vote to exclude another member of the group **(column 5, lines 10 - 40)**.

22. As per claim 31, Appelman teaches that access to the group is controlled **(column 4,lines 45-63 and column 5, lines 15-40)**.

23. As per claim 32, Appelman teaches that access is controlled using at least one of a password, payment of money, payment of services, and reference to a user preference **(column 4,lines 45-63 and column 5, lines 15-40)** .

24. As per claim 35, Appelman teaches:

a bus system; a communications unit connected to the bus system; a memory connected to the bus system, wherein the memory includes a set of instructions; and a processing unit connected to the bus system, **(column 3, lines 10-34; a bus is an inherent feature in computer**

systems) wherein the processing unit executes the set of instructions to receive a request from a requestor; compare preferences within the request a policy to form a comparison, wherein the policy controls responses by the data processing system to the requests; and selectively respond to the request based on comparison **(column 6, lines 52-67 and Figure 11).**

25. As per claims 37 – 45, 47-48, 53, 57-58, 64-65, 69-77, 79-80, 85, 89-90, and 96-97, these claims contain similar limitations as claims, 1-12, 14-15, 20, 24-25, and 31-32 above, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 13, 26-30 46, 59-63, 78, and 91-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman (U.S. Patent No. (6,750,881) in view of MacNaughton et al (U.S. Patent No. 6,020,884).

28. As per claim 13, Appelman fails to teach a membership in the group based on payment.

29. However, MacNaughton et al teach a service sign up process that requires billing information for the user **(column 9, lines 6-26).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton because MacNaughton's use of membership fee's in Appelman's system would allow for a peer to peer service to charge a usage fee in order to pay for servers and internet connections charges that the service occurs.

30. As per claim 26, Appelman fails to teach duration of membership within the group is unlimited.

31. However, MacNaughton et al teach that membership can include many different users of different profiles **(column 9, lines 5-26).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton because MacNaughton's use of unlimited membership in Appelman's system would allow for a peer to peer user to maintain a username in order to keep in touch with other users using the same username.

32. As per claim 27, Appelman fails to teach that duration of membership within the group is based upon receiving a payment from the member.

33. However, MacNaughton et al teach that membership is dependent on billing information **(column 9,lines 10-20).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton

because MacNaughton's use of membership fee's in Appelman's system would allow for a peer to peer service to charge a usage fee in order to pay for servers and internet connections.

34. As per claim 28, Appelman fails to teach that duration of membership within the group is based upon a presence of selected attributes.

35. However, MacNaughton et al teach that memberships are based on user profile **(column 9, lines 10-25).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton because MacNaughton's use of using memberships based on profiles in Appelman's system would allow a peer-to-peer service to maintain appropriate groups according to certain attributes. A service may allow a member that turns 18 to enter adult chat rooms.

36. As per claim 29, Appelman fails to teach that selected attributes include at least one of marital status, age, and interests.

37. However, MacNaughton et al teach that memberships are based on user profile **(column 9, lines 10 – 25).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton because MacNaughton's use of using memberships based on profiles in Appelman's system would allow a peer-to-peer service to maintain appropriate groups according to certain attributes. A service may allow a member that turns 18 to enter adult chat rooms.

38. As per claim 30, Appelman fails to teach that duration of membership within the group is based upon at least one of contributions to the peer-to-peer data processing system and usage of the peer-to-peer data processing system.

39. However, MacNaughton et al teach a tracking server that monitors user actions on chat sessions or messages and reporting these action s to community members **(column 9, lines 37-52; it is known in the art that in some chat sessions a chatter can get booted for inappropriate behavior).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and MacNaughton because MacNaughton's use of a tracking server in Appelman's system would allow a peer to peer service to view usage by users and boot users who behave inappropriately.

40. As per claims 46, 59-63, 78, and 91-95, these claims contain similar limitations as claims, 13, and 26-30 above, therefore are rejected under the same rationale.

41. Claims 33, 34, 66-67, and 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman (U.S. Patent No. (6,750,881) in view of Friedman (U.S. Patent No. 6,714,791).

42. As per claim 33, Appelman fails to teach the request is an advertisement.

43. However, Friedman teaches the use of advertisements in an instant message system **(column 3, lines 15-30).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Freidman because

Friedman's use of using advertisements in Appelman's system would allow a peer-to-peer service to send advertisements to users based on that user's profile or activity.

44. As per claim 34, Appelman fails to teach advertisements are targeted based on the preferences.

45. However, Friedman teaches targeted advertisements based on user's profile **(column 3, lines 15-30).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Freidman because Friedman's use of using advertisements in Appelman's system would allow a peer-to-peer service to send advertisements to users based on that user's profile or activity. This would allow a user to view ads that they may have interest in.

46. As per claims 66-67 and 98-99, these claims contain similar limitations as claims 33-34 above, therefore are rejected under the same rationale.

47. Claims 21-23, 54-56 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman (U.S. Patent No. (6,750,881) in view of Nessett et al (U.S. Patent No. 6,055,236).

48. As per claim 21, Appelman fails to teach the identity of the requestor is authenticated using a certificate.

49. However, Nessett et al teach authentication is based on a trusted third-party called a Certificate Authority **(column 25, lines 25-30).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Nessett because Nessett's use of authentication using a certificate in Appelman's system would allow a peer-to-peer service to use a third party to authenticate a user by proving the user's identity and supplying the service with a public key in which to decrypt the user encrypted messages.

50. As per claim 22, Appelman teaches identifying individuals in a group **(column 3, lines 34-46).**

51. Appelman fails to teach the use of certificates to identify users.

52. However, Nessett et al teach the use of certificates to identify users **(column 25, lines 25-53).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Nessett because Nessett's use of authentication using a certificate in Appelman's system would allow a peer-to-peer service to use a third party to authenticate a user by proving the user's identity and supplying the service with a public key in which to decrypt the user encrypted messages.

53. As per claim 23, Appelman fails to teach a certificate within the certificates is associated with at least one of an IP address and an e-mail address.

54. However, Nessett et al teaches certificates associated with IP addresses **(column 25, lines 25-52).** It would have been obvious to one of the ordinary skill in the art at the time of the

applicant's invention to combine the teachings of Appelman and Nessett because Nessett's use of certificates using IP addresses in Appelman's system would allow a peer-to-peer service to use a third party to authenticate a user by proving the user's identity and sending the public key to the IP address of the peer to peer service in order to decrypt the users encrypted messages.

55. As per claims 54-56 and 86-88, these claims contain similar limitations as claims 21-23 above, therefore are rejected under the same rationale.

56. Claims 16-19, 49-52, and 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman (U.S. Patent No. (6,750,881) in view of Walker et al (U.S. Patent No. 5,862,223).

57. As per claim 16, Appelman fails to teach that members in a group exchange compensation for the interaction.

58. However, Walker et al teach that users can bid for expert services on an electronic auction **(column 10, lines 27 – 43 and column 6, lines 55-65).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Walker et al because Walker et al's use of an electronic auction in Appelman's system would allow for members of the peer to peer service to auction goods and service by using instant messages to communicate and exchange compensation for these goods and services.

59. As per claim 17, Appelman fails to teach that compensation is financial, barter, or payment in kind.

60. However, Walker et al teach that a user spends money for expert services **(column 7, . lines 10-20).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Walker et al because Walker et al's use of an electronic auction in Appelman's system would allow for members of the peer to peer service to auction goods and service by using instant messages to communicate and to pay for these goods and/or services.

61. As per claim 18, Appelman fails to teach that compensation is based on are based on attributes of the interactions including at least one of a size of files transfer, a quality of a good, a quality of a service, a type of good, a type of server, and a member rating.

62. However, Walker et al teach that compensation is given to expert services **(column 7, lines 10-20).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Walker et al because Walker et al's use of an electronic auction in Appelman's system would allow for members of the peer to peer service to auction goods and service by using instant messages to communicate and to pay for these goods and/or services.

63. As per claim 19, Appelman fails to teach that compensation is managed using a clearinghouse.

64. However Walker et al teach the use of clearinghouse to manage compensation **(column 23, lines 47-67).** It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Appelman and Walker et al because Walker et al's use of a clearinghouse in Appelman's system would allow for members of the peer to peer service to auction goods and service by using instant messages to communicate and to pay for these goods and/or services and to exchange payment using a clearinghouse.

65. As per claims 49-52 and 81-84, these claims contain similar limitations as claims 16-19 above, therefore are rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Jiang (U.S. Patent No. 6,167,432)

b. Liles et al (U.S. Patent No. 5,880,731)

c. Wick (U.S. Patent No. 6,691,162).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey M Refai whose telephone number is (703) 605-4361 (after November 1, 2004 (571)272-3975). The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey M Refai
Examiner
Art Unit 2154

RMR
September 30, 2004